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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL W. FORNEY, RASHESH MODY, DAVE TRAN,
PRAMOD THAZHICHAYIL, VIJAY ANAND,
and KIMSON Q. NGUYEN

Appeal 2009-000054
Application 09/955,473
Technology Center 2100

Decided: September 16, 2009

Before HOWARD B. BLANKENSHIP, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

An oral hearing on this appeal was held on June 11, 2009. On August 24, 2009, Appellants filed a Request for Rehearing under 37 C.F.R. § 41.52(a)(1) (hereinafter “Request”) for reconsideration of our Decision mailed June 22, 2009 (hereinafter “Decision”).

Our Decision affirmed the Examiner’s rejection of claims 1-3, 5, 6, and 8-20 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Khan and Wewalaarachchi.

Our Decision also affirmed the Examiner’s rejection of claims 4 and 7 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Khan, Wewalaarachchi, and Polizzi.

We have reconsidered our Decision, in light of Appellants’ arguments in the Request for Rehearing, and we find no errors therein. We decline to change our prior Decision for the reasons discussed *infra*.

Appellants request reconsideration of the following two issues:

1. whether a sufficient reason exists, from the combined teachings of Kahn and Wewalaarachchi, under *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), to modify Kahn’s user-customized portal to provide access to plant process information provided by plant information sources such that claims 1-3, 5,6, and 8-20 are rendered obvious; and

2. whether the combined teachings of Kahn and Wewalaarachchi disclose a portal server that *comprises* an extensible set of data handlers such that claims 5, 8, 12-15 and 17-20 are rendered obvious.

(Request 2).

Issue 1

Regarding the first issue, Appellants ground their argument on the contention that the claim term “plant process information” should be construed by the Board as being limited to non-public and highly sensitive plant process information, as follows:

Appellants first request reconsideration of the Board Decision's focus upon Appellants' reference to "non-public, highly sensitive plant process information" rather than the claimed "plant process information" limitation. Plant process information is "non-public and highly sensitive" information. Circumstances are not reasonably foreseeable under which public access (as needed by Kahn's portal server which relies on users' specifying publicly accessible links to define a customized portal) is provided to plant process information. Therefore, Appellants' use of the phrase "plant process information" excludes the type of information considered accessible by the user-customizable portals based on Kahn's disclosed portal server architecture.
(Request 4-5).

In response, we decline to read the argued limitations of “non-public and highly sensitive” into the disputed claim term “plant process information.” We note that patentability is based upon the claims. “It is the claims that measure the invention.” *SRI Int’l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*). A basic canon of claim construction is that one may not read a limitation into a claim from the

written description. *Renishaw plc v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998). *See also In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

Moreover, we note that Appellants could have amended their claims during prosecution to recite the additional argued limitations of “non-public and highly sensitive” with respect to clarifying the meaning of the disputed claim term “plant process information.”¹ However, Appellants chose not to do so. Because “applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (citing *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)).

In addition, we observe that the claimed “plant process information” is not positively recited in representative claim 1 as being used to perform any machine-implemented function. Thus, Appellants’ argument (urging patentability based on the purported non-public and highly sensitive nature of the claimed “plant process information”) rests on nonfunctional descriptive material. The content of nonfunctional descriptive material is

¹ As stated in our Decision, “[w]e do not dispute Appellants’ argument that access to plant process information may be restricted in actual practice; however, we conclude that the plain language of the claims on appeal does not preclude open access to an information portal by users, such as taught by Khan (FF 1), as modified by Wewalaarachchi (FF 2-3).” (Decision, 9, ¶2).

not entitled to weight in the patentability analysis. *Cf. In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (“Lowry does not claim merely the information content of a memory. . . . Nor does he seek to patent the content of information resident in a database.”). *See also Ex parte Nehls* (BPAI Jan. 28, 2008), available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071823.pdf>; *Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (nonprecedential) (Fed. Cir. Appeal No. 2006-1003, *aff’d* Rule 36 June 12, 2006); Manual of Patent Examining Procedure (MPEP) § 2106.01 (Eighth ed., Rev. 7, July 2008).

For at least the aforementioned reasons, we find Appellants contention unpersuasive that “one skilled in the art *would not* consider modifying Kahn’s system to support access to plant process information since such modification would compromise the security of critical/sensitive information.” (Request 5, ¶2, last sentence, emphasis in original). Again, “critical/sensitive information” is not claimed, and even if we were to (impermissibly) read those argued limitations into the claim, Appellants’ argument for patentability remains grounded on the *type of information content* (“plant process information”), which is nonfunctional descriptive material. Accordingly, we decline to modify our original Decision regarding issue one.

Issue 2

We now consider the second issue of “whether the combined teachings of Kahn and Wewalaarachchi disclose a portal server that *comprises* an extensible set of data handlers such that claims 5, 8, 12-15 and 17-20 are rendered obvious.” (Request 2; *see also id.* at 6).

We observe that representative independent claim 8 recites in pertinent part: “an extensible set of data handlers for processing differing types of data from a set of plant information sources accessed via the portal server.”

We begin by noting that Appellants expressly admit in the Request that “[t]he Kahn reference does indeed disclose an extensible portal server.” (Request, 3, ¶3, first sentence under “The Prior Art” heading). However, Appellants argue strenuously that “[t]he combination of Kahn and Wewalaarachchi would not render a portal server comprising an extensible set of data handlers.” (Request 6, ¶3). In particular, Appellants state that “Wewalaarachchi discloses providing support for multiple different data types through a set of gateways (‘data handlers’) that are *separate* from a server that provides access to the data sources via the separate gateways.” (Request 6, ¶3, emphasis in original). Thus, Appellants read the claimed “extensible set of data handlers” (claim 8) on Wewalaarachchi’s gateways and conclude that the combination of Kahn and Wewalaarachchi “clearly teach[es] the set of data handlers executing outside a server.” (Request 7, ¶2, second sentence, emphasis added).

In response, we (and the Examiner) are reading the disputed “extensible set of data handlers” on Wewalaarachchi’s data objects, and not on Wewalaarachchi’s gateways, as incorrectly pointed to by Appellants (Request 6, ¶3). As set clearly forth in our Decision, we found that “Wewalaarachchi’s data objects (i.e., data handlers) provide subscribed information from a designated resource (i.e., device), *consistent with Appellants’ disclosed first form of extension* (FF 5).” (Decision 11, ¶1, emphasis added).

Thus, Appellants’ Request has misrepresented our Decision and is ineffective to show error in the Examiner’s factual findings and legal conclusion of obviousness. In particular, we find Appellants’ “teaching away” argument (Request 4, ¶1) to be moot, because we are reading the claimed data handlers on Wewalaarachchi’s data objects (and not on Wewalaarachchi’s gateways) (claim 8).

We particularly note that Appellants’ claim 8 is not limited to data handlers for processing different types of protocols (e.g., a gateway protocol converter). Instead, Appellants’ claim 8 more broadly recites: (in pertinent part) “an extensible set of data handlers for processing differing types of data from a set of plant information sources accessed via the portal server.” (emphasis added). As previously stated in our Decision, “we find the combination of Khan and Wewalaarachchi is at least suggestive of the claimed *extensible set of data handlers for processing differing types of data*.” (Decision 11).

We restate our reasoning and factual findings as set forth on pages 10-12 of our Decision, particularly the paragraph bridging pages 11 and 12 stating that the Examiner's rejection is based on the combination of cited references. Regarding Issue 2, we again find that the weight of the evidence supports the Examiner's position. See Decision 12.

CONCLUSION

We have considered the arguments raised by Appellants in the Request for Rehearing, but find none of these arguments persuasive that our original Decision was in error. We are still of the view that the invention set forth in claims 1-20 is unpatentable over the applied prior art based on the record before us in the original appeal. We have reconsidered our Decision but decline to grant the relief requested.

This Decision on Appellants' Request for Rehearing is deemed to incorporate our earlier Decision (mailed June 22, 2009) by reference. *See* 37 C.F.R. § 41.52(a)(1).

DECISION

We have granted Appellants' request to the extent that we have reconsidered our Decision of June 22, 2009, but we deny the request with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). *See also* 37 C.F.R. § 41.52(b).

REHEARING DENIED

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